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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Response to Amendment***

The claims as presented in the response of September 1, 2010 have been entered. However, pending claims 1, 4-10, 13, 14, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (US 2002/0198305) in view of Vasseur et al. (WO 02/088238) and Simonot et al. (US 2004/0030017) as described in the Final Rejection of March 16, 2010.

***Response to Arguments***

Applicant's arguments filed August 11, 2010 have been fully considered but they are not persuasive.

Applicants argue that Hopkins does not teach that its composition is used for passenger car tires. This argument is unpersuasive. The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). *See also Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. If so, the recitation serves to limit the claim. *See, e.g., In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). MPEP 2111.02.

In this case, the phrase “passenger car” refers to an intended end use of the tread composition. It does not add structural limitations to the claim. Therefore, the prior art invention needs only to be capable of serving the end use function, which it is. Hopkins teaches that its composition is used in tire tread compositions for vehicles and a passenger car is a type of vehicle. Further, the requirements for passenger car tire treads and truck or bus tire treads would

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not be that different. Cars, trucks, and buses all share the same roads and travel at around the same speeds on those roads. A difference may be expected to exist in the sidewall or carcass structure of the tires, but there is no evidence to support a difference in the tire tread compositions for those different intended uses. Moreover, even if it were true that differences in the tread compositions were present, a truck or bus tire tread would be capable of performing as a car tire tread. Therefore, this argument is unpersuasive.

Applicants argue that there is no apparent motivation for a person of ordinary skill in the art to add the triesters of Vasseur into the composition of Hopkins because Vasseur is directed to tires for a light passenger vehicle running at high speed and Hopkins is directed to a heavy vehicle running at a low speed. This argument is also unpersuasive. As discussed above, the composition taught in Hopkins finds utility in tire treads for all vehicles. It is not limited to those for "a heavy vehicle running at a low speed." The motivation listed above for combining the references in this manner, conserving grip performance, would be desirable for almost any type of tire and certainly tires for tires used to run typical vehicles on typical roads such as passenger cars, trucks, and buses.

Applicants argue that there would be no reasonable expectation of success for a modification of Hopkins with Vasseur. In making this assertion, applicants point to the fact that the composition of Hopkins differs from that of Vasseur. While the compositions between the two references are not the same, they both have similar utility (tire treads) and both contain diene rubbers (natural rubber and styrene butadiene rubbers, for example) as a component of their composition. One would not expect that the compositions would have to be exactly the same in order to expect success with a modification, especially when that modification deals with an additive to the composition.

Applicants argue that they have shown unexpected results. To that end, applicants point to examples C-1 and C-2 in their specification. This argument is unpersuasive. Only two examples are shown, one inventive and one comparative, and these examples do not give a good side by side comparison, i.e., more than one variable is changed between the two compositions and it is not clear from what change in the composition the change in results stems.

Additionally, even with the current claim amendments, broader ranges are claimed for each of

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the components in the claims than what is shown in the experiments. Therefore, these results are not commensurate in scope with the claims.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 9:00 am to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/MARK EASHOO/  
Supervisory Patent Examiner, Art Unit 1796

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Examiner, Art Unit 1796  
September 14, 2010